

In the Claims:

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Please cancel claims 1-24, and 35.

REMARKS

Please reconsider the rejections of the claims in light of the amendment and the following arguments and allow the pending claims.

First, the Examiner had previously issued a 3-way restriction requirement dividing the claims into groups I, II and III. On August 23, 2002, a provisional election was made with traverse to prosecute the invention of group II, claims 24-34. Please consider this response a confirmation of the election made with traverse to prosecute the invention of group II, claims 24-34. Applicants retain the right to prosecute the remaining claims in a later-filed divisional case.

Second, the Examiner rejected claim 24 under 35 U.S.C. § 112, second paragraph as being indefinite because claim 24 is a wiper article that depends from a "non-elected claim." Claim 24 is "a wiper formed by the method defined in claim 16." Applicants have canceled claim 24, thus mooted the Examiner's rejection.

Third, the Examiner rejected claims 25-28 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,678,704 to Fellows. Per the Examiner, the fabric of Fellows describes the essential limitations of the claimed invention including, for example, an impregnated fabric to which an indicator dye has been applied and which has a swellable polymer comprising a cationic starch material. Applicants respectfully submit that the present claimed invention differs from Fellows.

Fellows teaches the use of large cationic starch molecules that bond with the anionic dyes. See col. 2, lines 18-25. In contrast, claim 25 of Applicant's present application requires a water-swellaable polymer mixture applied to said web. On page 15, lines 22-31 through page 16, lines 1-5 of the present application, applicants exemplify polymers as adhesive-type polymers, including, but not limited to, acrylates, styrene butadiene, vinyl chlorides, methacrylates, acrylates, and vinyl acetates. Applicants also exemplify polymers as including polymers capable of becoming cross-linked when dried. Therefore, Fellows' *large cationic starch molecules bonded to an anionic dye* fail to anticipate applicants' claimed water-swellaable polymer mixture applied to said web.

To anticipate, every element and limitation of the claimed invention must be found in a single prior art reference, arranged as in the claim. Karsten Mfg. Corp. v. Cleveland Golf Co., 242 F.3d 1376, 1383, 58 USPQ2d 1286, 1291 (Fed. Cir. 2001); Scripps Clinic & Research Foundation v. Genentech, Inc., 927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991). Because Fellows does not disclose a "water-swellaable polymer" such as the ones set forth in the present application, Fellows cannot anticipate the pending claims. Therefore, it is respectfully requested that the Examiner withdraw the §102 rejection of claims 25-28.

II. Rejection of Claims 6-13 under 35 U.S.C. § 103(a) in view of U.S. Patent No. 5,858,554 to Neal, et al.

Fourth, the Examiner rejected claims 24-34 under 35 U.S.C. § 103(a) as being unpatentable over GB 2 211 092 in view of U.S. Patent No. 4,392,908 to Dehnel. Applicants have canceled claim 24, thus mooted the claim 24 rejection. Therefore, applicants are responding to the § 103(a) rejection of independent claim 25, in that claims 26-34 depend from independent claim 25. The Examiner stated that it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the water swellable polymer of Dehnel in the fabric of GB '092 motivated with the expectation that there would be an improvement in the absorbency of the wiper.

To establish a prima facie case of obviousness based on a combination of the content of various references, there must be some teaching, suggestion or motivation in the prior art to make the specific combination that was made by the applicant. In re Dance, 160 F.3d 1339, 1342 (Fed. Cir. 1998); In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1445 (Fed.Cir.1992). Moreover, the point in time that is critical for an obviousness determination is at the time of the invention. "To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." W.L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983). Obviousness cannot be established by

hindsight combination to produce the claimed invention. In re Gorman, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed.Cir.1991). It is the prior art itself, and not the applicant's achievement, that must establish the obviousness of the combination.

In addition, it has been repeatedly held by the Court of Appeals for the Federal Circuit that absent some teaching, suggestion, or incentive supporting a combination of references, obviousness cannot be established by combining the teachings of the prior art. ACS Hospital Systems, Inc. v. Montefiori Hospital, 732 F.2d. 1572, 1577, 221 U.S.P.Q. 929, 939 (CAFC 1984). This has been interpreted to mean that there must be a reasonable intrinsic or extrinsic justification for the proposed combination of references in order to properly reject the claims of an invention. The Examiner must propose some logical reason apparent from the evidence of record that justifies his combination or modification of the references. In re Regel, 188 U.S.P.Q. 132 (CCPA 1975). Therefore, it is important in the instant situation to examine whether or not there exists a reasonable intrinsic or extrinsic justification for the proposed combination of references. Applicants submit that the Examiner has failed to provide the requisite evidence or a specific motivation for combining these references.

GB '092 is silent as to water-swellaable polymers and is silent as to one dye component dissolving at a faster rate than an active chemical. Instead, GB '092 is directed to a dye indicator and active chemical, such as sunscreen and insect repellants, being transferred to a solid surface with the dye being an indicator of the successful transfer. GB '092 teaches that the successful transfer of the active chemical results in the successful transfer of the dye onto the surface area being wiped. Therefore, as the dye becomes depleted, the chemical is also simultaneously depleted.

In contrast, the present application claims the dye component dissolving at a faster rate than an active chemical in order to ensure that the article is not used after the active chemical becomes depleted.

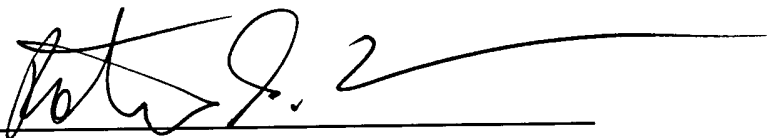
Dehnel is focused on providing a water-absorbent article with water-swellaable polymers to improve the absorbency of the article. Dehnel is silent as to a dye indicator and an active chemical. Therefore, there is no motivation (other than the hindsight motivation provided by applicant's application) to combine these two references. One is directed to determining how much of a chemical agent is transferred to a solid surface and the other is directed to improving the absorbency of a water-absorbent article. There simply is no specific motivation found in the art to combine these two different disclosures.

Even if one of ordinary skill in the art were to combine GB '092 and Dehnel, the combination would not meet every one of the limitations in claim 25 of the present application. See MPEP § 2142 - § 2143 (the prior references, when combined, must teach or suggest all the claim limitations). For example, the combination of GB '092 and Dehnel would not provide the claimed limitation of said at least one dye component dissolving at a faster rate than said active chemical when contacted with said liquid such that said color of said at least one surface becomes altered before said active chemical is completely exhausted. Because the combination of GB '092 and Dehnel would not meet every one of the limitations in claim 25 of the present application, the combination does not render the present application obvious under § 103. Therefore, it is respectfully requested that the Examiner withdraw the §103 rejection of claims 25-28.

In summary, in view of the foregoing arguments, we respectfully submit that the rejected claims are patentably distinct over the references cited by the Examiner and meet all other statutory requirements. We believe that the present Application is now in complete condition for allowance and, therefore, respectfully request the Examiner to reconsider the rejections in the Office Action and allow this Application. We invite the Examiner to telephone the undersigned should any issues remain after the consideration of this response. Please charge any additional fees that may be required to Deposit Account No. 50-2548.

Respectfully requested,

NELSON MULLINS RILEY & SCARBOROUGH

A handwritten signature in black ink, appearing to read 'Robert S. Thomas', is written over a horizontal line.

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Date

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